



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

116

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,663	02/08/2002	Charles Larry Bisgaier	5730-C1-01-FJT	4182
28880	7590	12/02/2004	EXAMINER	
WARNER-LAMBERT COMPANY 2800 PLYMOUTH RD ANN ARBOR, MI 48105			JIANG, SHAOJIA A	
			ART UNIT	PAPER NUMBER

1617

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/071,663

Applicant(s)

BISGAIER ET AL.

Examiner

Shaojia A. Jiang

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 2 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: noone.Claim(s) rejected: 32 and 33.Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

11/23/04
SHAOJIA ANNA JIANG
PATENT EXAMINER

Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejection of claim 31 made under 35 U.S.C. 112, first paragraph.

Art Unit: 1617

Advisory Action

This Office Action is a response to Applicant's amendment and response after FINAL filed on October 11, 2004, have been considered and will be entered.

3. Applicant's amendment after FINAL canceling claim 31 with respect to the rejection of claim 31 made under 35 U.S.C. 112, first paragraph, for scope of enablement, of record stated in the Final Office Action dated August 11, 2004 has been fully considered and found persuasive to overcome the rejection. Therefore, the said rejection is withdrawn.

5. Claims 32-33 amended as now are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (5,491,172) in view of Scolnick (WO 95/06470) for the same reasons of record stated in the Final Office Action dated August 11, 2004. Applicant's arguments with respect to this rejection have been fully considered but are unpersuasive for reasons of record stated in the Final Office Action. The rejection is maintained.

Again, as discussed in the Final rejection, the motivation to combine the teachings of the prior art cited herein to make the present invention is seen. The claimed invention is obvious in view of the prior art.

In particular, the record provides no working examples, i.e., testing results or data as factual evidence, demonstrating that any ACAT inhibitors in vitro or in vivo for treating Alzheimer's disease in a patient, in order to rebut the prima facie case herein.

Art Unit: 1617

Note that arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135,139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). Thus, Applicants are suggested to provide clear and convincing evidence of nonobviousness or unexpected results to rebut the prima facie obviousness rejection herein, as discussed in the telephonic interview November 23, 2004 with Applicant's attorney.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. 103(a). Therefore, said rejection is adhered to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9306.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'S. Anna Jiang', with a long, sweeping horizontal stroke extending to the right.

S. Anna Jiang, Ph.D.
Primary Examiner, AU 1617
November 23, 2004